

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed January 4, 2007. Claims 2 and 21 were previously cancelled without prejudice or disclaimer. Claims 1, 3-20, and 22-28 are pending in this Application. Claims 1, 3-20 and 22-28 stand rejected under 35 U.S.C. § 103. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 1, 5-15, 18, 20, 24, 27 and 28 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,996,450 issued to Edward J. Suttle (*"Suttle"*) in view of U.S. Patent No. 6,970,639 issued to John Mark McGrath (*"McGrath"*).

Claims 3, 4, 22-23 and 25-26 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Suttle* and *McGrath*, as applied to claim 1, in view of U.S. Patent No. 6,076,080 issued to William F. Morscheck (*"Morscheck"*).

Claims 16-17 and 19 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over *Suttle*.

Suttle discloses an automated manufacturing system and method for manufacturing photomasks based on information provided by a customer. (Col. 5, lines 40-44). The method and system includes software for processing photomask design data, where the software is configured to extract information from customer design data and arrange such data in a format suitable for performing photomask manufacturing tasks. (Col. 5, lines 57-61).

McGrath discloses an editing system for editing source content, such as audio or video. The system includes source metadata associated with the source content, template metadata defining a certain style for content, and a processing unit configured to apply the template to the source content by comparing the source metadata with the template metadata in order to arrange portions of the source content to produce an edited content sequence. (Col. 1, lines 29-39).

Claim 1 recites a method for order entry and processing in the manufacturing of a photomask component, comprising “automatically selecting a template including customer specifications based on at least one criteria related to the manufacture of the photomask component.”

Claim 20 recites a system for electronic order entry and automatic processing of a photomask component order comprising “executable instructions encoded in the computer-readable medium, the executable instructions, operable to direct a computer to ... select a template including customer specifications based on at least one criteria related to the manufacture of the photomask component.”

Claim 24 recites a method of manufacturing a photomask component, comprising “automatically selecting a template including customer specifications based on at least one criteria related to the manufacture of the photomask component indicated in the product order information file.”

Assuming for the sake of argument that the proposed *Suttle* and *McGrath* combination did disclose, teach or suggest the combination of limitations recited in Claim 1, which Applicants do not concede, the proposed *Suttle* and *McGrath* is improper. In particular, the Examiner has not shown the required suggestion or motivation to combine *Suttle* and *McGrath*. To establish a *prima facie* case of obviousness, the Examiner must show, among other things, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142. (emphasis added). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01. (emphasis added).

For example, regarding the proposed combination of *Suttle* and *McGrath*, the Examiner merely states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Suttle* to include automatically selecting a template including specifications based on at least on criteria; and validating the product order information file by automatically comparing the product order information file to the template to identify any inconsistencies, as disclosed in *McGrath*, wherein said criteria is related to the manufacture of

the photomask component because it would advantageously allow to significantly reduce amount of time reviewing the source content to get familiarized with the material to be edited, thereby improving the efficiency of the editing process, as specifically taught by McGrath (col. 1, Lines 20-25).

(Office Action, Pages 3-4). However, such reasoning fails to meet the requirement for combining the two references. If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to MPEP § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicants respectfully request that the Examiner produce and affidavit supporting such facts pursuant to MPEP § 2144.03. Applicants thus assume that the Examiner’s assertion that the proposed combination “would have been obvious” is based merely on speculation in hindsight, which is insufficient for supporting a modification or combination of references, under both the MPEP¹ and governing Federal Circuit case law².

Further, Applicants submit that the two references are concerned with and directed to different problems such that one skilled in the art of manufacturing photomasks, for example, would never consider looking to the teachings of a reference concerned with editing source content (video and/or audio material) to produce an edited content sequence. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must

¹ See M.P.E.P. § 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”)

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been met motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The significant difference between the subject matter with which *McGrath* is concerned and the subject matter with which Applicants are concerned is more than sufficient to negate anything taught by *McGrath* as motivating one skilled in the art to apply *McGrath's* teachings to *Suttle*.

For at least the foregoing reasons, Applicants submit that the proposed combination of *Suttle* and *McGrath* do not render obvious the limitations of Claims 1, 20 and 24. Given that Claims 3-19 depend from Claim 1, Claims 22 and 23 depend from Claim 20, and Claims 25-28 depend from Claim 24, Applicants respectfully submit that Claims 3-19, 22, 23 and 25-28 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections and allow Claims 1, 3-20, and 22-28.

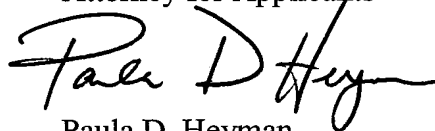
CONCLUSION

Applicants appreciate the Examiner's careful review of the Application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration of the rejections and full allowance of Claims 1, 3-20 and 22-28.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants


Paula D. Heyman
Registration No. 48,363

Date: March 5, 2007

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2581

512.322.8383 (fax)